



DT02 Rec'd PCT/PTO 09 JUN 2004

DAC
PATENT
P56218

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

CHANG-WOONG YOO

Serial No.: 09/718,371

Examiner: SHRADER, LAWRENCE, Technology Center 2100

Filed: 24 November 2000

Art Unit: 2124

For: COMPUTER SYSTEM AND METHOD CAPABLE OF AUTOMATICALLY INPUTTING PRODUCT KEY OF A SOFTWARE PROGRAM UPON REINSTALLING THE PROGRAM THEREON

RECEIVED

NOV 12 2004

PETITION UNDER 37 C.F.R. §1.181

Mail Stop : Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant respectfully petitions from the Examiner's assertion that applicant's Declaration fails to comply with 37 CFR §1.161 and the Examiner's requirement for a new Declaration, and petitions from the inability of the Examiner to comply with the mandate for completeness set forth and 37 CFR §1.104(a)(b) and (c) (as amended), and as reasons therefore, states that:

Folio: P56218
Date: June 9, 2004
I.D.: REB/ny

STATEMENT OF FACTS

1. In conjunction with the filing of the above-captioned pending U.S. application, applicant signed and dated a Declaration written in accordance with PTO/SB/01, which stated, *inter alia*:
 - “I acknowledge the duty to disclose information which is material to patentability and to the Examination of this application in accordance with title 37 of the code of federal regulations §1.56”; and
 - “I acknowledge the duty to disclose information material to patentability in title 37, the code federal regulations, §1.56(a) which became available between the filing date of prior application and the national or PCT International filing date of this application.”
2. In paper No. 7 issued by the Examiner on the 4th of June 2004, the Examiner wrote that:

“The declaration filed on 11/24/2000 is acknowledged. However, the Applicant must disclose information material to patentability under 37 CFR 1.56, not a portion of 37 CFR 1.56 (in this case 1.56a). See 37 CFR 1.61, which states that the declaration must “state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to

be material to patentability as defined in §1.56.” A new oath/declaration is required.”

As of the 4th of June 2004, the Commissioner, through the Office of Patent Legal Administration, continue to publish PTO/SB/01, which stated, in part, that

“I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT International filing date of the continuation-in-part application.”

3. During a telephone discussion with the Examiner on Monday the 7th of June 2004, the Examiner was (i) unable to state whether the language set forth by OPLA in PTO/SB/01 was unacceptable to the Examiner, (ii) whether the language set forth by OPLA in PTO/SB/01 fail to comply with 37 CFR §1.61; (iii) whether the Examiner had considered that applicant’s Declaration contained each word, statement, phrase and averment set forth in PTO/SB/01; (iv) that the Examiner had not considered that applicant’s Declaration contained two discreet and separate references to 37 CFR §1.56; (v) the Examiner stated that he was unfamiliar with any requirements of 37 CFR §1.104; (vi) the Examiner also stated that he had not confirmed with Office of Patent Legal Administration prior to issuing paper No. 7,

that the language set forth in PTO/SB/01 was unacceptable and did not comply with 37 CFR §1.61.

4. As of the 4th of June 2004, the Office had neither amended nor inserted language into 37 CFR §1.61; currently, 37 CFR §1.61 states nothing about the content of an oath or declaration.

REMARKS

Paper No. 7, in fact, challenges the completeness of the language set forth by the Office of Patent Legal Administration in PTO/SB/01 and holds that this language fails to comply with 37 CFR §1.61, despite the fact that §1.61 states nothing about Declarations or the language of Declarations. Moreover, 37 CFR §1.63(b)(3), simply states that the “person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in §1.56.” Office of Patent Legal Administration has incorporated to this requirement in the language set forth in PTO/SB/01.

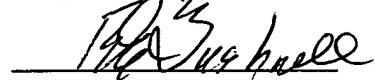
The Examiner has acknowledge that he has not conferred with OPLA about this issue, is unfamiliar with 37 CFR §1.61, and does not understand the issues raised by the two different references to 37 CFR §1.56 set forth in applicant’s declaration. Moreover, the Examiner stated that he is unfamiliar with 37 CFR §1.104.

RELIEF REQUESTED

The Commissioner is therefore, respectfully requested to:

- A. State in writing that applicant's Declaration(s) are in full compliance with the code of federal regulations, specifically, 37 CFR §1.63 and any requirement imposed upon the applicant to acknowledge a duty of disclosure under 37 CFR §1.56;
- B. Return paper No. 7 to the Examiner for revision in compliance with 37 CFR §1.104(a), (b) and (c);
- C. Withdrawal the Examiner's requirement for a substitute Declaration; and
- D. Grant such other and further relief as justice may require.

Respectfully submitted,



Robert E. Bushnell
Attorney for the Applicant
Registration No.: 27,774

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Washington, D.C. 20005
(202) 408-9040

Folio:P56218
Date:6/9/04
I.D.: REB/ny

DECLARATION

Docket No. _____



AS A BELOW NAMED INVENTOR, I hereby declare that:

My residence, post office address and citizenship are as stated next to my name.

I believe that I am the original, first and sole ^{only one name is listed below} or an original, first and joint inventor ^{multiple names are listed below} of the subject matter which is claimed and for which a patent is sought on the invention entitled:**TITLE:**

the specification of which either is attached hereto or otherwise accompanies this Declaration, or:

was filed in the U.S. Patent & Trademark Office on _____ and assigned Serial No. _____

and *(if applicable)* was amended on _____

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above. I acknowledge the duty to disclose information which is material to patentability and to the examination of this application in accordance with Title 37 of the Code of Federal Regulations §1.56. I hereby claim foreign priority benefits under Title 35, U.S. Code §119(a)-(d) or §365(b) of any foreign application(s) for patent or inventor's certificate, or §365(a) of any PCT International application which designated at least one country other than the United States, or §119(e) of any United States provisional application(s), listed below and have also identified below any foreign applications for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Priority Claimed:
Yes [] No []

(Application Number)	(Country)	(Day/Month/Year filed)	Yes [] No []
_____	_____	_____	Yes [] No []
_____	_____	_____	Yes [] No []

I hereby claim the benefit under Title 35, U.S. Code, §120, of any United States application(s), or §365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application(s) in the manner provided by the first paragraph of Title 35, U.S. Code, §112, I acknowledge the duty to disclose information material to patentability as defined in Title 37, The Code of Federal Regulations, §1.56(a) which became available between the filing date of the prior application and the national or PCT international filing date of this applicatio

(Application Serial No.)	(Filing Date)	(STATUS: patented, pending, abandoned)
_____	_____	_____
_____	_____	_____

I hereby revoke all previously granted powers of attorney and appoint the following attorneys: Robert E. Bushnell, Reg. No. 27,774, Michael D. Parker, Reg. No. 34,973, Darren R. Crew, Reg. No. 37,806 and Saryadvinder Sahota, Reg. No. 47,051, to prosecute this application and to transact all business in the U.S. Patent & Trademark Office connected therewith and with any divisional, continuation, continuation-in-part, reissue or re-examination application, with full power of appointment and with full power to substitute an associate attorney or agent, and to receive all patents which may issue thereon, and request that all correspondence be addressed to:

Robert E. Bushnell,
Attorney-at-Law
Suite 300, 1522 "K" Street, N.W.
Washington, D.C. 20005-1202

Payor No. 008439
Area Code: 202-638-5740

I HEREBY DECLARE that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 U.S. Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

FULL NAME OF FIRST OR SOLE INVENTOR: _____

Citizenship: _____

Inventor's signature: _____

Date: _____

Residence & Post Office Address: _____

FULL NAME OF SECOND JOINT INVENTOR: _____

Citizenship: _____

Inventor's signature: _____

Date: _____

Residence & Post Office Address: _____

FULL NAME OF THIRD JOINT INVENTOR: _____

Citizenship: _____

Inventor's signature: _____

Date: _____

Residence & Post Office Address: _____

FULL NAME OF FOURTH JOINT INVENTOR: _____

Citizenship: _____

Inventor's signature: _____

Date: _____

Residence & Post Office Address: _____



Additional inventors are being named on separately numbered sheets attached hereto.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

**DECLARATION FOR UTILITY OR
DESIGN
PATENT APPLICATION
(37 CFR 1.63)**

Declaration
Submitted
With Initial
Filing

OR

Declaration
Submitted after Initial
Filing (surcharge
(37 CFR 1.16 (e))
required)

Attorney Docket Number	
First Named Inventor	
<i>COMPLETE IF KNOWN</i>	
Application Number	
Filing Date	RECEIVED
Art Unit	NOV 12 2004
Examiner Name	Technology Center 2100

I hereby declare that:

Each inventor's residence, mailing address, and citizenship are as stated below next to their name.

I believe the inventor(s) named below to be the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

(Title of the Invention)

the specification of which

 is attached hereto**OR** was filed on (MM/DD/YYYY) as United States Application Number or PCT InternationalApplication Number and was amended on (MM/DD/YYYY) (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, inventor's or plant breeder's rights certificate(s), or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached? Yes	Certified Copy Attached? No
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

 Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

[Page 1 of 2]

This collection of information is required by 35 U.S.C. 115 and 37 CFR 1.63. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.